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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/098,637	03/13/2002	Slim Souissi	267/108	7391

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EXAMINER
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HASHEM, LISA

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/098,637

Applicant(s)

SOUISSI ET AL.

Examiner

Lisa Hashem

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 5-11, and 13-16 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent No. 6,333,973 by Smith et al, hereinafter Smith.

Regarding claim 1, Smith discloses a method for complete message delivery to a multi-mode communication device (Fig. 1, 1100) (see Abstract), comprising: receiving a message notification through a first communication channel (GSM signaling channel), (col. 7, lines 15-24), the message notification corresponding to a complete message (col. 7, line 40 – col. 8, line 10); connecting to a message server (e.g. voice mail server; Fig. 5, 5600) via the Message Center (Fig. 6, 6100) through a second communication channel (voice B-channel); and downloading the complete message through the second communication channel (col. 9, lines 35-60).

Regarding claim 2, the method of claim 1, wherein Smith further discloses the message notification is a mobile terminated SMS message (col. 7, lines 15-24; col. 9, lines 35-40).

Regarding claim 5, the message of claim 1, wherein Smith further discloses parsing the message notification to determine a set of parameters pertaining to the complete message (Fig. 7A; col. 7, line 51-col. 8, line 10).

Regarding claim 6, the method of claim 5, wherein Smith further discloses the set of parameters comprises a sender and a subject (col. 8, lines 1-10 and lines 52-65; col. 9, lines 6-11; Fig. 8A).

Regarding claim 7, the method of claim 6, wherein Smith further discloses the set of parameters further inherently comprises a priority (col. 8, lines 1-10 and lines 46-65; Fig. 7A).

Regarding claim 8, the method of claim 5, wherein Smith further discloses the set of parameters comprises a unique message identifier (Fig. 7A; col. 8, lines 27-65).

Regarding claim 9, the method of claim 5, wherein Smith further discloses comparing the set of parameters to an established criteria for retrieving complete messages (col. 7, line 40 – col. 8, line 65).

Regarding claim 10, Smith discloses a method for complete message delivery to a multi-mode communication device (Fig. 1, 1100) (see Abstract), comprising: receiving a complete message addressed to a communication device; constructing a message notification corresponding to the complete message; sending the message notification to the communication device through a first communication channel (GSM signaling channel), (col. 4, lines 15-25; col. 7, lines 15-24); receiving a download request from the communication device; and sending the complete message to the communication device through a second communication channel (voice B-channel) (col. 9, lines 35-60).

Regarding claim 11, the method of claim 10, wherein Smith further discloses the message notification is a mobile terminated SMS message (col. 7, lines 15-24; col. 9, lines 35-40).

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Regarding claims 13-16, please see the rejections to claims 5-8 above, respectively, to reject the method in claims 13-16.

3. Claims 17-23 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent No. 6,625,461 by Bertacchi.

Regarding claim 17, Bertacchi discloses a system for complete message delivery to a multi-mode communication device (Fig. 1, 10), comprising: a first communication network or first area and a second communication network or second area; a communication device adaptable to communicate over the first communication network and the second communication network (col. 4, lines 16-40); a message control module or message center (Fig. 1, 22) configured to receive a complete message addressed to the communication device, notify the communication device of the message, and provide the complete message to the communication device upon request (col. 1, lines 23-41; col. 4, lines 16-26).

Regarding claim 18, the system of claim 17, wherein Bertacchi further discloses a database or HLR adaptable to store a registration status pertaining to the communication device (col. 4, lines 27-40), wherein the communication device reports the registration status to the message control module via the VMSC (col. 7, lines 52-57) and the message control module inherently updates the database, the HLR converts the stored location information into an SMS address that is used by the message center (col. 7, line 62 – col. 8, line 16).

Regarding claim 19, the system of claim 17, wherein Bertacchi further discloses the message control module notifies the communication device of the complete message via the first communication network, wherein said device has not roamed out of the first area (col. 1, lines 23-41).

Regarding claim 20, the system of claim 17, wherein Bertacchi further discloses the message control module notifies the communication device of the complete message via the second communication network, wherein said device has roamed into the second area via the VMSC (col. 4, lines 16-26; col. 8, lines 10-16).

Regarding claim 21, the system of claim 17, wherein Bertacchi further discloses the complete message is provided to the communication device via the first communication network, wherein said device has not roamed out of the first area (col. 1, lines 23-41).

Regarding claim 22, the system of claim 17, wherein Bertacchi further discloses the complete message is provided to the communication device via the second communication network via the VMSC, wherein said device has roamed into the second area (col. 4, lines 16-26; col. 8, lines 10-16).

Regarding claim 23, the system of claim 17, wherein Bertacchi further discloses a message filter (within the message center) inherently configured to screen the complete message prior to notifying the communication device of the complete message (e.g. find the location of said device prior to notification) (col. 4, lines 23-26).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 3 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, as applied to claims 1 and 10 above, respectively, and in further view of U.S. Patent Application Publication No. Us 2005/0048958 by Katz et al, hereinafter Katz.

Regarding claim 3, the method of claim 2, wherein Smith does not disclose the SMS message is encrypted.

Katz discloses a method for complete message delivery to a multi-mode communication device, comprising: receiving a message notification that is a SMS message and is encrypted (section 0090, line 1 – section 0091, line 38).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Smith to include SMS encryption as taught by Katz. One of ordinary skill in the art would have been lead to make such a modification since encrypting a SMS message to allow an authorized user to receive a message notification.

Regarding claim 12, please see the rejection of claim 3 above, to reject the method in claim 12.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, as applied to claim 1 above, respectively, and in further view of U.S. Patent Application Publication No. Us 2005/0048958 by Mousseau et al, hereinafter Mousseau.

Regarding claim 4, the method of claim 1, wherein Smith does not disclose the connecting step comprises establishing a secure VPN connection.

Mousseau discloses a method for complete message delivery to a multi-mode communication device (Fig. 1, 100) (see Abstract), comprising: receiving a message by establishing a secure VPN connection (section 0037, line 1 – section 0039, line 6).

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Smith to include VPN as taught by Mousseau. One of ordinary skill in the art would have been lead to make such a modification since VPN provides security in downloading messages to the communication device, wherein authorized users can view messages.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- U.S. Patent No. 6,771,949 by Corliss discloses a method for complete message delivery to a multi-mode communication device wherein a message notification is a mobile terminated SMS message

8. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
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**Or faxed to:**

(703) 872-9314 (for formal communications intended for entry)

**Or call:**

(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to: Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (703) 305-4302. The examiner can normally be reached on M-F 8:30-5:30.




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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

LH

lh

March 10, 2005

  
FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600